7A, 10A and 10B and on pages 18 and 21. Support for new claim 18 can be found in the paragraph spanning pages 13-14. Support for new claim 19 can be found on page 18. Support for new claim 20 can be found in Figure 1 and on pages 10-11 and 13. Support for new claim 21 can be found in Figure 1 in the first full paragraph on page 11and in the paragraph spanning pages 13-14. Support for new claim 22 can be found in the last paragraph on page 10. Support for new claim 23 can be found in Figure 1. Support for new claim 24 can be found the paragraph spanning pages 13-14. Support for new claim 25 can be found in Figure 1.

1. Double Patenting Rejection

On pages 2 and 3 of the Official Action, the Examiner rejects claims 1-5 under the judicially created doctrine of double patenting over claims 1-3 of co-pending Application 09/745,099. It is not clear to the Applicants whether double patenting is present. While Applicants are prepared to file a terminal disclaimer, Applicants are presenting herein the claims from co-pending application 09/745,099 to assist the Examiner in further determining the presence of double patenting. If the Examiner does not issue a restriction requirement to as to claims 6-9, and 19-22, this will evidence that double patenting may be present and Applicants will simply bring all of the claims of USSN 09/745,099 into the present application.

2. 35 USC § 102

On page 3 of the Official Action, the Examiner rejects claims 1-5 as being anticipated by Blake (5,643,275) under 35 U.S.C. 102(b). The Examiner states "Blake discloses...a lens package (12) for storing the lens in a state in which no stress acts on the optical portion of the lens...". Applicants disagree with the Examiner for the reasons noted below, Applicant submits that Blake does not disclose a system as claimed in claim 1 of the current application. Furthermore Applicants respectfully submit that claim 6 is also not anticipated by Blake.

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2.1 Claim 1

Claim 1, as amended, recites "*An insertion system for an intraocular lens, comprising: ... the insertion device having a means for removably holding the lens package, the means for removably holding being associated with and in communication with the insertion tube, the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*" (emphasis added). The Examiner asserts that the lens package is reference 12 in Blake. Blake defines reference 12 as a compression portion, see col. 4, line 55. Thus, Blake does not disclose a lens package. However, even if the Examiner continues to hold the belief that the compression portion 12 of Blake is a lens package, Blake does not disclose "*the insertion device having a means for removably holding the lens package*". In addition, Blade does not disclose "*the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*". As is clear from the Figures of Blake the support for compression portion 12 is not parallel to the major axis of the insertion tube. Thus, Applicant submits claim 1 is not anticipated by Blake.

2.2 Claim 6

On page 3 of the Official Action regarding US Patent App. No. 09/745,099 dated September 4, 2001, the Examiner rejects pending claim 1 as being anticipated by Blake (5,643,275) under 35 U.S.C. 102(b). Pending claim 1 of US Patent App. No. 09/745,099 is now reflected in new claim 6 of the present application. Thus, the Applicant submits arguments in support of the patentability of claim 6.

Claim 6 corresponds to claim 1 in US Patent App. No. 09/745,099 with additional amendments. Claim 6 recites, "*said lens moving mechanism lockably engaging with said holding means in a first position when said lens is held at said standby position*". Blake discloses an intraocular lens injector that compresses an intraocular lens by rolling the lens into a tight spiral and injects the compressed lens through a relatively small incision in the eye, see the abstract of Blake. Blake does not disclose "*the lens moving mechanism lockably engaging with the holding means in a*

first position when the lens is held at the standby position". Therefore, Applicant submits claim 6 is not anticipated by Blake.

3.3 Remaining Claims

In view of the foregoing, it is respectfully submitted that Blake does not anticipate claims 1 and 6 under 35 USC 102(b). In addition, the arguments submitted in reference to claim 1 can be applied to independent claims 10 and 23. Further, the arguments submitted in reference to claim 6 can be applied to independent claim 19. Thus, it is submitted that Blake does not anticipate claims 10, 19 or 23. Claims 2-5, 7-9, 11-18, 20-22, and 23-30 are also not anticipated by Blake through at least their dependency on claims 1, 6, 10, 19 or 23.

3. Non-obviousness of Claims 1 and 6 over Blake

3.1 Claim 1

Claim 1 is non-obvious over Blake. Blake provides no motivation or suggestion for "*the insertion device having a means for removably holding the lens package*" or "*the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*" as recited in claim 1 of the instant invention.

The benefit of the insertion device having an "*open portion shaped to receive the lens package*" is to facilitate the rapid and easy insertion of the lens into an injection device in the operating room. With the present invention, the lens package is simply dropped into the means for holding the package and the operation continues. In contrast, in Blake where the insertion portion 14, with the lens rolled up inside, is detached from the compression portion 12 of the lens injector 10 and is attached to the injection handle 50, see col. 8, lines 51-53.

In addition, Blake teaches, "...the lens 65 is preferably positioned such that the haptics 66 are perpendicular to the side walls 65 of the intraocular lens receiving chamber 18. The shuttle member 16 is then inserted into the intraocular lens receiving chamber 18 with the scoop end 24

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such that the scoop end 24 is tangential to the bottom surface 28 of the cylindrical passageway 20." See col. 7, lines 27-34. Blake further teaches that the shuttle member 16 then "forces the lens...to take on a cylindrical shape" (column 7, lines 59-60). It follows that Blake provides no hint or suggestion of "*the insertion device having a mans for removably holding a lens package*". In addition, Blake does not teach or suggest "*the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*". Thus, it is submitted that claim 1 is patentable over Blake.

None of the other references cited by the Examiner teach or suggest "*the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*". For example, Figueroa (US. Pat. No. 5, 873,879) discloses a cannula 22 with an open proximal end which defines an inner cavity 101sized to matingly receive the assembled shelf segment 29 and cover 21. Thus Figueroa teaches an open portion shaped to receive the lens package that is perpendicular to the major axis, rather than "*the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package*" as is claimed in the present application. Thus, it is submitted that claim 1 is patentable over the prior art cited thus far.

Applicant has resolved the problem of easy positioning of a lens device in an insertion system with its means for holding. The cited art is not similar and therefore is not easy to use.

3.2 Claim 6

In addition, Blake does not teach or suggest "*the lens moving mechanism lockably engaging with the holding means in a first position when the lens is held at said standby position*" recited in claim 6 of the current invention.

The benefit of the insertion device having "*the lens moving mechanism lockably engaging with the holding means in a first position when the lens is held at the standby position*" facilitates the operator's ability to control when the lens is prepared for injection. With the present invention, the lens is held in the stand-by position until such time as the operator moves the lens into the

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injection position. The lockable engagement of the lens moving mechanism with the holding means prevents accidental movement of the lens from the standby position to the injection position.

Blake teaches the shuttle member 16 is preferably keyed to match a compatible keying means on the intraocular lens receiving channel 18 such that the shuttle member 16 can only be inserted into the lens receiving channel in only one direction, see col. 5, lines 5-8. In addition, Blake teaches that the shuttle member is gently manually urged forward and pushes the intraocular lens 65 towards the cylindrical passageway 20, see col. 7, lines 45-47. However, Blake does not teach or suggest "*the lens moving mechanism lockably engaging with the holding means in a first position when the lens is held at the standby position*". Thus, Applicant submits that claim 6 is patentable over Blake.

Further, none of the other references cited by the Examiner teach or suggest "*a lens moving mechanism lockably engaging with the holding means*". Thus it is submitted that claim 6 is patentable over the cited prior art. Applicant has resolved the problem of holding the lens in a standby position until the operator is ready to move the lens into the insertion position with the lens moving mechanism lockably engaging with the holding means. The cited are is not similar and therefore does not provide the control provided by the present invention.

3.3 Remaining Claims

In view of the foregoing, it is respectfully submitted that claims 1 and 6 are patentable over Blake. In addition, the arguments submitted in reference to claim 1 can be applied to independent claims 10 and 20. Further, the arguments submitted in reference to claim 6 can be applied to independent claim 17. Thus, it is submitted that claims 10, 17 and 20 are deemed to be patentable as well. Claims 2-5, 7-9, 11-17, 18-19, and 21-25 are deemed to be patentable through at least their dependency on claims 1, 6, 10, 17 or 20.

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The Commissioner is authorized to charge any additional fees, which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

No new matter has been added. Reconsideration of this application is respectfully requested.

I hereby certify that this correspondence is being deposited with The United States Post Office with sufficient postage as first class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231 and being facsimile transmitted to (703) 872-9302 on

December 28, 2001
(Date of Deposit)
Mavis Gallenson
(Name of Applicant, Assignee or Registered Representative)

(Signature)

12/28/01
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APPENDIX A

1. An insertion system for an intraocular lens, comprising:

an intraocular lens having a deformable optical portion;

a lens package for storing the lens in a state in which no stress acts on the optical portion of the lens;

[deforming means for deforming the lens to a reduced size;] and

an insertion device having an insertion tube through which the deformed lens is inserted into an eye, the insertion device having a major axis, the insertion device having a means for removably holding the lens package, the means for removably holding being associated with and in communication with the insertion tube, the means for removably holding defining a support which lies parallel to the major axis and an open portion opposite the support, the open portion shaped to receive the lens package; and

a pusher mechanism for pushing and inserting the lens into the eye[, wherein

[the lens package has a function for attachment to the insertion device and a function for acting as portion of the mechanism to be provided by the insertion device].

2. An insertion system for an intraocular lens according to claim 1, further comprising a deforming means, wherein the deforming means is formed integrally with the insertion tube.

3. An insertion system for an intraocular lens according to claim 1, further comprising a deforming means, wherein at least a portion of the deforming means is formed integrally with the lens package.

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